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Victor R. Blake

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EXAMINER

MURDOUGH, JOSHUA A

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/606,545	<b>Applicant(s)</b> BLAKE ET AL.	
	<b>Examiner</b> JOSHUA MURDOUGH	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-10,37-40,42-44 and 48-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-10,37-40,42-44 and 48-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This action is responsive to Applicants' amendments received 17 September 2009.
2. This action has been assigned paper number 20100111 for reference purposes only.
3. Claims 1, 2, 4, 6-9, 10, 37-40, 42-44, and 48-50 are pending.
4. Claims 1, 2, 4, 6-9, 10, 37-40, 42-44, and 48-50 have been examined.

### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 48 and 49 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

7. Claim 48 recites "said permitted connections available through said plurality of servers include licenses allocated to said mail servers." Applicants' specification does not indicate that a "license allocated to said mail servers" is a type of "permitted connection." Moreover, it is the Examiner's position that the use of a license as a permitted connection would not have been in the skill of one of ordinary skill in the art. If Applicants can provide support for a license as a

connection either from, (1) their specification or (2) a prior art document, citing the particular passage(s), the Examiner will withdraw this rejection.

***Claim Rejections - 35 USC § 112 2nd Paragraph***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 48-50 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 48 recites "said permitted connections available through said plurality of servers include licenses allocated to said mail servers" which renders the claim indefinite. A license is a file representing a right or rights. Therefore, one of ordinary skill in the art would not understand how a license can be a permitted connection. Instead of being the connection, the license could give the right to make a connection.

11. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 7, 8, 10, 12, 13, 16, 37, 38, 40, 42, and 44 are rejected under 35

U.S.C. §102(b) as being anticipated by Freeman (US 2001/0049717).

14. Claims 1, 2, 7, 8, 10, 12, 13, 16, 37, 38, 40, 42, and 44 rejected under 35 U.S.C. §103(a) as being unpatentable over Freeman (US 2001/0049717) in view of Cullen (US 2003/0105800) further in view of Eggleston (US 5,764,899).

15. As to claims 1, 12, 13, 37, and 42, Freeman shows:

a. A method, comprising:

b. receiving a request to access a network resource **510** accessible through each of a plurality of servers (Figure 1), wherein licenses to access said network resource ("connection licenses," [0366]) are distributed to each respective said servers **180** and wherein a total of said licenses distributed to said servers corresponds to a maximum limit of allowed licensed connections to said network resource ("control the number of user connections allowed," [0366]);

c. determining whether granting the requested access to the network resource provides a number of licensed connections equal to or less than said maximum limit ("control the number of user connections," Id.);

d. granting the requested access to the network resource if it is determined that the granting of the requested access provides said number of licensed connections equal to or

less than said maximum limit (“control the number of user connections allowed,”  
[0366]); and

e. using load balancing to direct said granted requested access to one of said servers  
having at least one of its said respective licenses available for said requested access  
[0348+].

16. Freeman does not expressly show:

f. load balancing according to license availability; and

g. providing a warning message if a threshold limit, of a number of licensed  
connections less than said maximum limit of licensed connections is reached.

17. However, Cullen teaches load balancing according to software application availability  
[0036]. The software application is tied to the license to determine use (Id.). Therefore, it would  
have been obvious to one of ordinary skill in the art at the time of the invention to have modified  
the teaching of Freeman to alter the load balancing to be based upon license availability. Load  
balancing based on the software availability would allow for more effective use of the granted  
licenses and potentially reduce the number of licenses needed because the balancing would find  
available licenses so they can be used.

18. The Freeman/Cullen combination does not expressly show:

h. providing a warning message if a threshold limit, of a number of licensed  
connections less than said maximum limit of licensed connections is reached.

19. However, Eggleston teaches providing a warning message if said maximum bandwidth  
limit of licensed connections is reached (Column 3, lines 57-65) or approached (Column 4, lines  
1-3).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Freeman to include a warning as the number of connections approaches the limit because Freeman deals with connections on a per connection basis (“control the number of user connections allowed,” [0366]) instead of by bandwidth. This would allow better monitoring of traffic and to give more advanced warning that the licensed number of connections may need to be increased.

21. As to claim 2, Freeman further shows:

said network resource includes an application available from each of said servers [0350].

22. As to claim 7, Freeman further shows:

keeping at least one of a local log or syslog to track information associated with licensed connections to the network resource [0362].

23. As to claims 8, 40, and 44; Freeman further shows:

comprising providing third-party (administration) access to at least one of the local log or syslog to allow licenses associated with the tracked information stored therein to be remotely managed or monitored [0362].

24. As to claim 10, Freeman further shows:

associated maximum limits of allowed licensed connections, of a plurality of network resources, are arranged according to a parent/child arrangement [0170] (“ParentID;” if there is a parent, there is also a child.).

25. As to claim 38, Freeman further shows:

said network device is a switch **204** adapted to direct said requested access to said one of said servers **180**, which are communicatively coupled to said switch (Figure 2A).

26. Claims 4, 6, 39, 43, and 48-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Freeman, Cullen, Eggleston in view of Bullard (US 6,405,251).

27. As to claims 4, 6, 39, 43, and 48-50, Freeman and Cullen disclose as discussed above in regards to claims 1, 12, 37, and 42.

28. Freeman further shows:

i. a data repository (“administration tool subsystem,” [0362]), included in said network device and accessible by said network device (part of the LMS subsystem, Id.), to store log information usable by said network device to determine usage of, and compliance with an agreement pertaining to, said paid permitted connections (“maintain a log of client connections for future reference,” [0362]).



29. Freeman, Cullen, and Eggleston do not expressly disclose:

j. said servers include mail servers and wherein said licenses distributed to said servers include licenses allocated to a plurality of said mail servers based on usernames assigned to said mail servers; or

k. said servers include mail servers and wherein said licenses distributed to said servers include license allocated to said mail servers based on geographic information associated with users that request access to the network resource.

30. However, Bullard teaches:

l. said servers include mail servers (Column 5, lines 52-53) and wherein said licenses distributed to said servers include licenses allocated to a plurality of said mail servers based on usernames assigned to said mail servers (Column 21, lines 13-15); and  
m. said servers include mail servers (Column 5, lines 52-53) and wherein said licenses distributed to said servers include license allocated to said mail servers based on geographic information associated with users that request access to the network resource (Column 14, lines 47-52).

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Freeman to make the servers mail servers with the usernames and geographic information as described by Bullard. This would allow for better arrangements of the servers due to the increased information about the servers, resulting in more efficient communications as this information indicates potential communications delays due to distance and hops.

***Claim Interpretation***

32. Applicants are reminded that optional or conditional elements (*e.g.* claim 1 which recites "providing a warning message if a threshold limit, of a number of licensed connections less than said maximum limit of licensed connections, is reached") do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C.: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]" and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

33. If a positive recitation is desired and if Applicants' original specification supports such an amendment, the Examiner respectfully suggests amending the claim to recite, *e.g.* "upon reaching a threshold limit, of a number of licensed connections less than said maximum limit of licensed connections, providing a warning message."

34. The Examiner again directs Applicants' attention to MPEP § 2106 II. C. where it states that statements of intended use may be subject to reduced patentable weight. The Examiner's position is that when a limitation describes what a component is to do or for, except when invoking 112 6<sup>th</sup> paragraph, the limitation is not positive and therefore interpreted as intended use. For example, claim 49 recites "a data repository...to store log information usable by said network device to determine usage of, and compliance with an agreement pertaining to, said paid permitted connections." The data repository is not "programmed to store" nor is it recited that it "stores log information." Therefore, the Examiner's position is that this limitation does not effect the structure required to infringe. Also in this limitation, the use of "usable...to

determine” falls short of requiring a particular structure because the data repository is not programmed to perform the actions.

35. Applicants are cautioned that the phrase “adapted to” may not impart the desired weight to the claim limitations. See MPEP §§ 2106 II. C. and 2111.04. The Examiner respectfully suggests using “programmed to” if Applicants’ specification supports such an amendment.

36. Although it is the Examiner’s position that the optional, intended use, and “adapted to” limitations should not receive full patentable weight, he has still provided references and citations for Applicants convenience.

### ***Response to Arguments***

37. Applicant's arguments filed 17 September 2009 have been fully considered but they are not persuasive.

38. Applicants argue:

39. “In the above-quoted passage from Eggleston, he clearly teaches a limit of user "data transfer" or group "data transfer," rather than a limit of "connections." Stated in another way, Eggleston limits the amount of data being transferred. In comparison, claim 48 recites "maximum limit of paid permitted connections" (emphasis ours). It is respectfully submitted that the amount of data transfer that is limited by Eggleston is different from the limit of connections recited in claim 48” (Remarks, Page 9, Paragraph 4).

40. Examiner's response:

41. The Examiner agrees that the exact conditions of the warnings are different between Eggleston and the instant claims. However, the Examiner is relying on Eggleston to teach a warning before reaching a limit when dealing with data connections. Freeman already deals with the connections on a per connection basis. Therefore, the Examiner is merely citing Eggleston for the warning prior to a limit being reached, not the exact conditions taught.

42. Applicant's other arguments with respect to claims 1, 2, 4, 6-10, 37-40, 42-44 and 48-50 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

43. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

44. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

45. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

n. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112 1<sup>st</sup> paragraph.

o. Independent of the requirements under 35 U.S.C. § 112 1<sup>st</sup> paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the

specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

47. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

48. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621

***Requirement for Information under 37 C.F.R. § 1.105***

49. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. See MPEP §§ 704.10-704.14

50. During the telephonic interview on 21 August 2009 the Examiner indicated there was evidence that may result in a requirement for information. Applicants acknowledged there may be a requirement for information in their summary of the interview provided with their remarks on 17 September 2009. This evidence was found by the Examiner, upon updating the search for the interview.

51. During the search, the Examiner found documents that while not providing sufficient evidence to support a prima facie on sale bar rejection, do suggest that further documents may exist that do support an on sale bar. Those documents are: "Foundry Networks Announces Application Aware Layer 7 Switching on ServerIron Platform" ("ServerIron") and "Galileo Announces Breakthrough Network Management Technology for Ethernet Switches; Partnership with emWare Creates a New Class of Web emPowered Switches" ("Galileo").

52. Because ServerIron discusses a product, which was released in 1999, that appears similar to that which Applicants claim, the Examiner believes there may be additional evidence which could support an on sale bar rejection under 35 U.S.C. § 102(b).

53. Also, there are indications that Applicants competitors may have had comparable products for sale in 1999. Because Galileo shows at least one competitor appears to be making similar switching products, the Examiner believes others are likely to have been made.

54. Because Applicants are in the best position to provide this information about their products and the identity of the competing product(s) the Examiner requires the following:

55. In regards to the claimed subject matter of “load balancing according to license availability” the Examiner requires particular information.

56. In response to this requirement, please provide the names of any products or services sold by the Assignee that have incorporated the claimed subject matter as set forth in Paragraph 55. Moreover, please provide the citation for, the dates initially published, and copies of any advertising and promotional literature prepared for any products or services named. In addition to the names, advertising, and promotional literature, please also provide facts related to public use or sale situations for the identified products or services.

57. Additionally, in response to this requirement, please identify any known products and services produced by any competitors embodying the disclosed subject matter as set forth in Paragraph 55 and identify the properties of these competitors products and services found in the prior art.

58. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant’s disclosure.

59. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant’s



first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

60. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 C.F.R. § 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

61. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Joshua Murdough  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621